

**Applicants: Volpe et al.
Application No.: 09/844,057**

REMARKS/ARGUMENTS

After the foregoing amendments, claims 2-11, 13-19, 21, 22 and 24-28 are pending. Claims 25 through 28 are amended. No new matter has been entered by these amendments.

Interview

Applicants thank the Examiner for conducting an interview with Applicants' representative on September 5, 2006 at 10 am. Applicants' representative submitted a draft of its arguments in support of patentability of the claims. During the interview, it was stated that the independent claims would likely be allowable if the term "DJ performance materials" was further defined in the independent claims to reflect the arguments in the draft. Applicants have amended the independent claims in accordance with this suggestion and for the reasons set forth below, respectfully submit that the independent claims are allowable.

Withdrawal of Finality of Office Action

Second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is not necessitated by applicant's claim amendments. MPEP § 706.07(a) (emphasis added).

The July 5, 2006 Final Action rejected claims 2, 3, 5-9, 11, 15-17, 21, 22, 25, 26, 27 and 28 as amended in Applicants' March 9, 2006 Reply, on new grounds; as being anticipated under 35 USC § 102(e) by Gorbet (U.S. Pat. No. 6,072,480). But

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this new ground of rejection was not necessitated by Applicants' March 9, 2006 amendments. According to page 2 of the Final Action, the use of client-related materials was always present in Gorbet, it was just missed previously. Thus, the 102(e) rejection of the above-referenced claims could have been raised by the PTO prior to this Action. As such, Applicants' March 9, 2006 claim amendments could not have necessitated the new ground of rejection. In view of the foregoing, Applicant respectfully requests that the finality of the Action be withdrawn.

Claim Rejections - 35 USC § 102(e)

Claims 2, 3, 5-9, 11, 15-17, 21, 22, 25, 26, 27 and 28 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Gorbet.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." See Schering Corp. v. Geneva Pharms., Inc., 339 F.3d 1373, 1379 (Fed. Cir. 2003); see also MPEP § 2131.

According to the Action, Gorbet discloses "DJ performance materials" because the slide show program includes code for controlling an electronic slide show. Gorbet discloses that the DJ performance materials are "arranged with and among client selected, event related materials" because the slide contains a sound clip embedded therein. Finally, Gorbet discloses "a DJ like performance related to the

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future event is fixed on the recording media" because the slideshow presentation can be saved for future playback. See page 6.

Amended, independent claim 25 claims, in relevant part, "DJ performance materials comprised of a human being's creative, customized performance based upon the collection of client selected, event related materials, the DJ performance materials arranged with and among the client selected, event related materials such that a DJ like performance related to the future event is fixed on the recording media." These elements are also claimed in independent claims 26, 27 and 28.

Applicants respectfully traverse the rejection based on these amendments. As provided in the amended independent claims, "DJ performance materials" refers to a Disc Jockey; a human being, taking information from the client about the event and its guests and what songs the client would like to hear and then compiling a creative, current performance based on this information using the DJ's creativity and experience. See paragraph [0003] (A DJ typically tailors or customizes the performance to entertain predetermined guests at these events). The DJ decides when to play the songs, when and how to "mix" them into other songs to create a smooth transition to keep the guests dancing, when to tell certain jokes, etc., and compiles this performance on a recordable media. See paragraph [0003]. (A DJ's performances typically include playing songs, telling jokes, passing on interesting

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anecdotes and making event announcements). In one embodiment, the DJ even chooses some of the material to be played. See paragraph [0017].

A computer code is not a human being as is the "Disc Jockey" of the present invention. Even assuming *arguendo* that Gorbet's code can be likened to a "DJ" the code does not provide "DJ performance materials". Gorbet's code is not creative. It does not interject its own "performance", it does not decide when slides are "played" or how to transition them, it does not interject jokes, etc. The client programs the "slide show module", which contains the code (see Gorbet, col. 6, lines 18-20) to do exactly what the client inputs and the code, obeys that input. Id. For example, the "client" (presenter) inputs exactly which slides are going to be played when, how they are transitioned and any accompanying sounds, music, visual effects, etc. The code simply executes these commands. It changes the slide either at the predetermined time, set by the user or when the user "clicks" the mouse, plays the sounds or music, etc. (see Gorbet, col. 6). In sum, in Gorbet, the "client" determines the content of the performance and exactly how the presentation is arranged; the code and computer simply execute the client's commands. In the present invention, the client determines most but in most cases not all of the content of the performance, and the DJ adds content, arranges and records the performance. This is provided for in the amended, independent claims. Therefore, Gorbet does not disclose "DJ performance materials" as claimed in the independent claims.

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Because the code does not provide DJ performance materials, Gorbet cannot disclose “a DJ like performance . . . fixed on the recording media.” In addition, in the present invention, the *DJ* records the performance on the recording media. In Gorbet, the “client” (presenter) records the performance on the “recording media”.

In sum, the computer code of Gorbet does not disclose “DJ performance materials arranged with and among client selected, event related materials, such that a DJ like performance related to the future event is fixed on the recording media.” As such, Gorbet does not disclose every element of independent claims 25, 26, 27 and 28 and therefore, cannot anticipate those claims. Claims 2, 3, 5-9, 11, 15-17, 21 and 22 depend from amended, independent claims 25, 26, 27 and 28 and therefore, are also allowable.

Claim Rejections - 35 USC § 103(a)

Claims 10, 13, 14 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gorbet. Claims 25-28 are allowable for the reasons stated above and therefore, dependent claims 10, 13, 14 and 19 are allowable. Claims 10, 13, 14 and 19 are allowable for the following, additional reasons.

To establish a *prima facie* case of obviousness, three basic criteria must be met. MPEP 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Id.

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Second, there must be a reasonable expectation of success. Id. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Id.

Claim 10

In rejecting claim 10 the Action found that Gorbet discloses every element of claim 10 except that the "other information is guest information." The Action found that "it is well known that slide show presentations such as Power Point presentations are geared toward their audience" because "an English professor may have a presentation for display to his students related to Shakespeare". The "guest information" claimed in claim 10 is information relating to the event (i.e., a wedding, etc.) the guests, personally. See paragraph [0013]. This information includes stories and idiosyncrasies, anecdotes, about the guests personally. Id. An English professor would not include personal information about his students as a part of his Power Point presentation. Therefore, Gorbet in combination with alleged information known in the art does not render claim 10 obvious.

Claim 13

Claim 13 is allowable for the same reasons as claim 10. Furthermore, in rejecting claim 13 the Action found that Gorbet discloses "wherein the gathering of client selected, event related materials is in response to a play list and information" because in Gorbet, "the *author* edits the slides . . . and the *author* selects one of

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three custom soundtrack options.” Page 13 (emphasis added). But in the present invention the *DJ*, not the “client” or “author”, gathers the client selected, event related materials in response to a play list and information provided by the client. Therefore, Gorbet does not teach or suggest *all* the claim limitations and does not render claim 13 obvious. See MPEP 2143.

Claim 14

Claim 14 is allowable for the same reasons as claim 10. Any “stories and idiosyncrasies” provided by an English professor would be about the subject of the lecture only and not about the “guests”; i.e., the students, personally. In addition, Applicants respectfully submit that the Examiner must provide documentary evidence capable of demonstrating “instantly and unquestionably” that it is inherent that an English professor would provide stories and idiosyncrasies in his presentation. See MPEP § 2144.03. The Wikipedia “reference” does not provide instant and unquestionable proof. The Examiner did not rely upon the Wikipedia reference. See page 3. Wikipedia is not dated, presumably, because it is editable by anyone, any time, for any reason and therefore, is generally unreliable. And, nowhere in Wikipedia is there any reference to the phrase “guest information.” In fact, the majority of Wikipedia is devoted to the history and “Cultural Effects” of PowerPoint. The one section of Wikipedia regarding the operation of PowerPoint does not discuss the content of a presentation or individual slides being “geared

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toward" the audience. Wikipedia includes one reference to PowerPoint being widely used by "educators," but it is devoid of any reference to the example provided by the Examiner of an English professor creating or presenting a presentation for students relating to Shakespeare.

Claim 19

With respect to claim 19, the Action states that "Gorbet fails to disclose accepting a security deposit from the event client prior to the step of providing." But the Examiner took "official notice" that taking a security deposit is notoriously well known in the art and cited U.S. Patent No. 5,161,250 to Ianna in support of that contention.

The Examiner did not provide the specific column, paragraph, lines, or even the page of Ianna that supports his contention. As previously provided, when the Examiner takes official notice he must provide documentary evidence capable of demonstrating "instantly and unquestionably" the information that he took official notice of. See MPEP § 2144.03. Ianna discloses taking a deposit, but this is merely in the Background section of the patent. Applicants respectfully request that the Examiner provide the required documentary evidence of the officially noticed fact. See MPEP § 2144.03, Part C.

For the foregoing reasons, Applicants respectfully submit that claims 10, 13, 14 and 19 are allowable.

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In addition, even assuming *arguendo* that these arguments are not persuasive, Applicants respectfully submit that it is improper to make the rejection of claim 19 final because this is the first action in which Ianna was cited and this was not precipitated by Applicants amendments. In the prior Action, the Examiner cited Raspberry World Media because of a typographical error carried over from the previous rejection. See page 4. Therefore, the finality of the final rejection of claim 19 should be withdrawn.

Claims 4, 18 and 24

Claims 4, 18 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gorbet in view of Bakos (U.S. Pat. No. 6,511,728). According to the Action, Gorbet does not disclose that the media has a predetermined life span; however, Bakos discloses an *optical* media that can only be used for a limited period of time and it would have been obvious to one of ordinary skill in the art to record the slide show of Gorbet onto a CD with a limited life. (emphasis added).

Because claims 25, 26 and 28 are allowable for the reasons stated above, dependent claims 4, 18 and 24 are allowable. In addition, the virtual DJ performance of the present invention includes optical and audio aspects whereas Bakos discloses only an *optical* media. Therefore, it would not have been obvious to one of skill in the art at the time of the invention to combine Gorbet and Bakos to create an optical and audio media. There is no record basis for the combination of

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Gorbet and Bakos except the present application, and the rejection cannot stand to render claims 4, 18 and 24 obvious.

For the foregoing reasons, Applicants respectfully submit that claims 4, 18 and 24 are allowable.

Conclusion

Applicants respectfully request reconsideration and further examination of the application based on the above-referenced arguments. If the Examiner believes that another interview will advance prosecution of this application, the Examiner is invited to contact the undersigned to arrange an interview at the Examiner's convenience.

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In view of the foregoing remarks, Applicants respectfully submit that the pending claims are in condition for allowance and a notice to that effect is respectfully requested.

Respectfully submitted,

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